

Paper No. _____
Filed: July 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC,
Petitioner

v.

ALKERMES PHARMA IRELAND LIMITED,
Patent Owner

Case IPR2018-00943
Patent 7,919,499

Joint Motion to Terminate Case No. IPR2018-00943

I. Precise Relief Requested

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R § 42.74, Petitioner Amneal Pharmaceuticals LLC and Patent Owner Patent Owner Alkermes Pharma Ireland Limited (collectively, “the Parties”) jointly request termination of the above-captioned *Inter Partes* Review of U.S. Patent No. 7,919,499 (“the Patent-at-Issue”), Case No. IPR2018-00943.

II. Reasons for Granting the Motion

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized the filing of the instant motion in an email communication dated July 29, 2019. Pursuant to that authorization, this Joint Motion to Terminate Case No. IPR2018-00943:

(1) includes a brief explanation as to why termination is appropriate; (2) identifies all parties in any related district court litigation involving the patent in dispute and discusses the current status of each such related litigation with respect to each party of the litigation; and (3) identifies the case numbers of any pending, related *inter partes* review proceedings.

A. Brief Explanation of Why Termination Is Appropriate

Termination of this proceeding is appropriate because (i) oral arguments have not been presented to the Board, (ii) Petitioner will no longer be participating in this proceeding, and (iii) the Board has not yet decided the merits of the

proceeding. The Parties have settled their disputes and executed a Settlement and License Agreement that authorizes the Parties to seek termination of this *inter partes* review.

B. Pending District Court Litigations Involving the '499 Patent

As noted in the Parties' Mandatory Notices, there are no related district court litigations involving the '499 patent.

C. Pending *Inter Partes* Review Proceedings Involving the '499 Patent

As noted in the Parties' Mandatory Notices, there are no related *inter partes* review proceedings involving the '499 patent.

III. Settlement Agreement

This motion is accompanied by Exhibit 2058, a true and correct written copy of the Parties' Settlement and License Agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). No other such agreements, written or oral, exist between or among the Parties.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and to the separate request being concurrently filed herewith, the Parties jointly request that the Settlement and License Agreement be treated as business confidential information and be kept separate from the files of the above-captioned IPR and of the '499 patent.

IV. Conclusion

For all of these reasons, the Parties respectfully request termination of this proceeding.

Respectfully submitted,

Dated: July 30, 2019

By: /Tedd W. Van Buskirk/
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Counsel for Petitioner
Anneal Pharmaceuticals LLC

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Patent Owner
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Petitioner a true and correct copy of the foregoing JOINT MOTION TO TERMINATE CASE NO. IPR2018-00943, by electronic means, on July 30, 2019, at the following address of record:

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Dated: July 30, 2019

Respectfully submitted,

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